

Remarks

Claim 41 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim has been amended to correct the antecedent basis.

Claims 1,2,4,13-16,18,19,29,30,41,46,48,49,53,63 stand rejected under 35 U.S.C. 102(b) as being anticipated by Berlit et al.

Berlit discloses a plant container made of synthetic thermoplastic material. (Berlit et al., GB2073567A, Title). Berlit provides Figures 2 through 5 that show various embodiments of the wall construction of a plant container 10. (Berlit, pg. 1, lines 95-97). Figure 2 shows a two layer construction of the walls, consisting of an opaque inner layer 11 and a decorative outer layer 12 that is coextruded on top of the layer 11. (Berlit, pg. 1, lines 97-107). Figure 3 shows a three layer construction, consisting of the same opaque inner layer 11 and decorative outer layer 12 with an additional intermediate colour-shielding layer 13. (Berlit, pg. 1, lines 115-117). Figure 4 shows a four layer construction, consisting of the inner layer 11, the outer layer 12, and the intermediate layer 13 with the inner layer overlaid by an additional layer 14. (Berlit, pg. 1, lines 115-117 and 123-125). Finally, Figure 5 shows a three layer construction, consisting of the same inner layer 11 and outer layer 12 (as in Figure 1) with the inner layer overlaid by an additional layer 14. (Berlit, pg. 1, lines 123-125).

There is no support for the Examiner's assertion that Berlit's layers 11 and 14 are root-tip-trapping material and that Berlit's layers 12 and 13 are root-impenetrable material. (See Office Action of Oct. 9, 2003, pg. 2). The only distinction that Berlit makes about these layers is that layer 11 is opaque, layer 12 is decorative, optional layer 13 is colour shielding and optional layer 14 is nonharmful. On the basis of this limited disclosure, there is nothing to lead one of ordinary skill in the art to reach the conclusion that the opaque and nonharmful layers will trap root tips and that the decorative and

colour shielding layers are root impenetrable. There is no such teaching in Berlit and one of ordinary skill in the art would not know this from reading the specification of Berlit.

Improper hindsight reconstruction of the claims must be carefully avoided, even in the context of an anticipation rejection. The Berlit reference has been considered since the original search, yet the disclosure was not recognized as providing sufficient clarity and detail to establish that the subject matter of the present claims existed. The Berlit reference was then cited in the first office action as merely a secondary reference to an obviousness rejection. After withdrawing those rejections, a second office action was provided with Berlit again serving only as a secondary reference to an obviousness rejection. Only now, in the third office action, has Berlit been elevated as the basis of an anticipation rejection. It seems illogical that a reference that cannot support an obviousness rejection would ever be asserted as anticipatory.

Berlit expressly states that the two layered construction of Figure 2 is formed by "co-extrusion." (Berlit, pg. 1, lines 105-107). Furthermore, "[t]he laminate shown in Figures 3 to 5 is also manufactured by co-extrusion." (Berlit, pg. 1, lines 127-129). The McGraw-Hill Dictionary of Scientific and Technical Terms, Sixth Edition, defines *extrusion* as "a process in which a hot or cold semisoft solid material, such as metal or plastic, is forced through the orifice of a die to produce a continuously formed piece in the shape of the desired product." The same dictionary defines *coextrusion* as "extrusion-forming of plastic or metal products in which two or more compatible feed materials are used in physical admixture through the same extrusion die."

Accordingly, the fact that the layers are coextruded, along with the illustrations of Figures 2-5, shows that the thermoplastic layers are solid and form relatively smooth and continuous interfaces between layers and relatively smooth and continuous inner and outer surfaces. (Berlit, Figures 2-5). Berlit makes no suggestion to use a root-tip-trapping layer, and his teaching that the layers are coextruded leads away from the use of a root-tip-trapping layer because these coextruded thermoplastic layers would not trap roots.

The Applicant's present independent claim 1 includes the phrase "a layer of a root-tip-trapping material bonded to a layer of a root-impenetrable material." The Examiner has rejected claim 1, along with claim 48, under 35 U.S.C. Section 102(b) as

being anticipated by Berlit et al. because “Berlit et al. disclose a root growth barrier comprising a layer of a root-tip-trapping material 11,14 bonded to a layer of a root-impenetrable material 12,13.” (Office Action mailed Oct. 9, 2003 at pg. 2). However, any assertion that Berlit discloses a root-tip-trapping layer has been shown to be incorrect as explained above, since all of these layers 11,12,13,14 are coextruded.

The present specification establishes that “[t]he layer or layers of *root-tip-trapping material* of the root growth barrier may be any fabric that, when bonded to a layer of a root-impenetrable material on one side surface (i.e. face-to-face), will provide the bilayer composite with the capacity to trap an actively growing root tip between the fabric’s fibers (within the fabric’s openings) and against the root-impenetrable material.” (Specification, p. 6, ln. 7-11). There is no such material disclosed by Berlit.

The Court of Appeals for the Federal Circuit has established the law that:

An anticipating reference must describe the [patented] subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *ATD Corp v. Lydall, Inc.*, 159 F.3d 534, 548 (Fed. Cir. 1998)

Berlit provides absolutely no disclosure of root-tip-trapping or root-tip-trapping material, and the Examiner has failed to establish a prima facie case of anticipation of claim 1 or any other claim containing the limitation of a “root-tip-trapping material.” Berlit does not describe any root-tip-trapping material at all, let alone with sufficient clarity and detail necessary to establish that the subject matter of the claims existed and that its existence was recognized by persons of ordinary skill in the field of the invention.

Applicant respectfully requests withdrawal of this rejection.

The foregoing anticipation rejection is the only rejection asserted against independent claims 1, 29, 46, 48, 49 and 57. Having shown that these claims are not anticipated by Berlit, these claims should be promptly allowed along with the claims depending therefrom.

With regard to the anticipation rejection of claim 4, the reference to “the root-tip-trapping material being polypropylene *which is a porous fabric*” is not supported by the Berlit specification. (See Office Action of Oct. 9, 2003 at pg. 2). It is undisputed that Berlit discloses the use of polypropylene (Berlit, pg 1, line 66 and pg. 2, line 2), but there is no express or inherent basis to support either that Berlit’s polypropylene is *porous* or that Berlit’s polypropylene is a *fabric*.

The McGraw-Hill Dictionary of Scientific and Technical Terms, Sixth Edition, defines *polypropylene* as “[a] crystalline, thermoplastic resin made by the polymerization of propylene, C₃H₆; the product is hard and tough, resists moisture, oils and solvents, and withstands temperatures up to 170°C; used to make molded articles, fibers, film, rope, printing plates, and toys.” Thus, polypropylene is neither inherently porous nor inherently a fabric.

Additionally, Berlit’s layers are coextruded thermoplastics and there is no express or inherent teaching that any of these layers would be capable of trapping root tips as defined in the present specification and claims. Applicant respectfully requests withdrawal of this rejection.

Claims 3,5-7,25,26,31,32,50,51,64,65 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Berlit et al. Applicant reasserts its foregoing remarks regarding the Berlit reference, and asserts that this obviousness rejection is not supported by a proper reading of Berlit.

Berlit discloses multiple embodiments of containers having different numbers of layers, but none of the layers are provided for the purpose of root-tip-trapping. There is no support for the Examiner’s assumption underlying the present rejection that Berlit’s layers 11 and 14 are root-tip-trapping material and that Berlit’s layers 12 and 13 are root-impenetrable material. (Office Action of Oct. 9, 2003, pg. 2). The only distinction that Berlit makes about these layers is that layer 11 is opaque, layer 12 is decorative, optional layer 13 is colour shielding and optional layer 14 is nonharmful. On the basis of this limited disclosure, there is nothing to suggest to one of ordinary skill in the art that the opaque and/or nonharmful layers will trap root tips and that the decorative and/or colour

shielding layers are root impenetrable. Similarly, there is no suggestion in Berlit to modify or replace any of the layers with a root-tip-trapping material.

Improper hindsight reconstruction of the claims must be carefully avoided. It is the prior art that must suggest the desirability of the modification. The Berlit disclosure does not provide the requisite desirability or motivation.

Claims 8-11,33-35,42,44,52 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Berlit et al. (as above) in view of Reiger (US 6202348).

In the second office action, mailed on March 24, 2003, claims 1-11, 13-16, 18, 19, 25, 26, 29-35, 41, 42, 44, 46, 48-53, 55, 56, 63-65 were rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger (U.S. Patent No. 6,202,348) in view of Berlit, *et al.* (GB 2,073,567 A). Applicant's remarks included, among other things, an assertion that there is no motivation to combine the Reiger and Berlit references. While the primary and secondary references have now been reversed in the making the present rejection of many of the same claims, the Examiner is making the same combination of references without addressing the Applicant's earlier remarks regarding the lack of motivation to combine the references. It is stated in MPEP Section 707.07(f) that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." The Applicant reasserts that it is improper to combine these two references and requests a reasoned statement of the alleged basis for a motivation to combine.

As already set out, Berlit discloses a container made from coextruded thermoplastic layers including an opaque layer to block light from reaching the roots. By contrast, Reiger '348 discloses a removable and reusable fabric liner that may be inserted into a pot, then later removed from the pot so that the liner can be easily removed from growing media by peeling the fabric away. (Reiger '348, col. 3, lines 61-63; and col. 8, lines 18-21). There is no motivation to combine references with such conflicting teachings. Applicant respectfully requests specific attention to this argument, including a specific citation to that portion of the references that is being relied upon to support the requisite motivation to combine.

In making the present rejection, the Examiner asserts that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a spun bonded, needle punched fabric as taught by Reiger in place of the polypropylene porous fabric of Berlit et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice, for both material[s] will trap roots.” (Office Action of October 9, 2003 at pg. 5).

First, the reference to “the polypropylene porous fabric of Berlit et al.” is not supported by the Berlit specification. Apparently, this term was derived from the comments earlier in the office action, where it was stated that “Berlit et al. further disclose the root-tip-trapping material being polypropylene *which is a porous fabric.*” (Office Action of Oct. 9, 2003 at pg. 2). It is undisputed that Berlit discloses the use of polypropylene (Berlit, pg 1, line 66 and pg. 2, line 2), but there is no basis to support either that Berlit’s polypropylene is *porous* or that Berlit’s polypropylene is a *fabric*. Applicant reasserts the remarks made above regarding the definition of polypropylene.

Applicant asserts that Berlit’s polypropylene layer is not porous and will not trap root tips. As discussed earlier in this response, Berlit’s layers are coextruded thermoplastics and there is no suggestion that any of these layers are, or should be modified to be, porous or capable of trapping root tips as defined in the present specification and claims.

Furthermore, in an earlier office action, the Examiner cited *In re Leshin*, 125 USPQ 416 (CCPA 1960), in support of the proposition being asserts again here – namely, that it is “within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice.” (See for example, Office Action of March 24, 2003, pg. 12). The Appellant in *In re Leshin* claimed a container-dispenser for cosmetics that resembled a common lipstick holder with minor mechanical differences. On appeal to the Board, the Appellant acknowledged that the Root reference, which showed a metal lipstick container, disclosed the general structure being claimed. While the independent claim 13 did not specify the material that

the device was made of, the dependent claims 14 and 15 were limited to plastic. However, the Anderson reference showed a container of molded plastic similar to claims 14 and 15. In addressing the patentability of these dependent claims 14 and 15 that added the limitation of the plastic material, the Court stated that the “[m]ere selection of known plastics to make a container-dispenser of a type made of plastics prior to the invention, the selection of the plastics being on the basis of suitability for the intended use, would be entirely obvious; . . .” *In re Leshin*, 277 F.2d 197, 199, 125 USPQ 416 (CCPA 1960).

The present situation is not analogous to the facts of *In re Leshin*. While the appellant in that case acknowledged structural identity between the device claimed and the device disclosed by the prior art reference, the present Applicant has shown that there is no structural identity between the spun bonded, needle punched fabric or other fabrics claimed and the coextruded thermoplastics layers disclosed in the Berlitz reference. Because there is no structural identity, there is much more at issue here than “mere selection of known plastics.” *Id.*

It must also be emphasized that the correct statement of this decision is that the “mere selection of *known plastics* . . . on the basis of suitability for the intended use, would be entirely obvious.” *Id.* This case did not hold it to be within the general skill of a worker in the art to “select a *known material* on the basis of its suitability for the intended use as a matter of obvious choice.” (See Office Action of Oct. 9, 2003 at pg. 5). This case means that where a prior art plastic device and a claimed plastic device have an identical structure, but are made of different plastic compositions that are both suitable for the intended purpose, then the claimed device is obvious.

However, it is not obvious to substitute a coextruded thermoplastic layer with spun bonded, needle punched fabric, because this is much more than a mere selection of plastic compositions. Rather, the substitution asserted by the Examiner as being obvious constitutes a wholesale replacement of one structure for another structure, namely a coextruded sheet structure for a fibrous fabric structure. Applicant respectfully requests reconsideration and withdrawal of the present rejection.

For prior art references to be combined to render obvious a subsequent invention under 35 U.S.C. Section 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. *In re Fine*, 5 U.S.P.Q.2d at 1599 (Fed. Cir. 1988). Hindsight is strictly forbidden. It is impermissible to use the claims as a framework from which to pick and choose among individual references to recreate the claimed invention. *Id.* at 1600; *W.L. Gore*, 220 U.S.P.Q. at 312. Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Thus, a rejection under 35 U.S.C. Section 103 grounded on a combination of references cannot be sustained unless the particular combination is suggested by the prior art itself. Applicant asserts that the prior art makes no suggestion to combine Berlit and Reiger and that the Examiner has not met her affirmative duty to show such a suggestion in the art. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Berlit as modified by Reiger as applied to claim 1 above, and further in view of Thomas (US 5311700). Applicant reasserts that the combination of Berlit and Reiger is improper. The inclusion of Thomas does nothing to make the combination proper.

Thomas teaches that the use of a "penetrable, water permeable liner within the basket, made of polyurethane foam." (Thomas, col. 2, lines 23-24). During growth, the roots of the plant will penetrate the lining and will air prune. (Thomas, col. 2, lines 26-28). Thomas also teaches that if air pruning of the roots on the bottom of the root ball is undesirable, (Thomas, beginning at col. 4, line 50) the bottom exterior may be covered with a root choking material 50. (Thomas, col. 4, line 67 through col. 5, line 1; and Figure 6). The material 50 may be a tightly woven synthetic cloth, since natural material

(cotton, sisal, burlap, etc.) would rot and would then promote rather than hinder root growth. (Thomas, col. 5, lines 1-14).

The Examiner asserts that "Thomas teaches a root growth barrier such as a container for a plant in which he employed cotton for a root-growth resistant material 50 (col. 5, line 11)." (Office Action of Oct. 9, 2003 at pg. 6). First, Thomas actually teaches away from the use of cotton as either a root-growth resistant material or a root-tip-trapping layer, because Thomas says that the cotton would rot and then promote root growth rather than hinder root growth. (Thomas, col. 5, lines 10-13). Second, Thomas teaches that a synthetic cloth may be used to cover a *root penetrable liner*. Therefore, Thomas' teachings are in conflict with the solid pots of both Berlit and Reiger. Third, Thomas' permeable, root-penetrable liner results in air pruning of the roots of the plant. (Thomas, col. 3, lines 63-68). Accordingly, there is no suggestion to combine Thomas with Berlit, since Thomas is addressing permeable layers for air pruning and cording, whereas Berlit is using impermeable layers that do no pruning at all. Fourth, there is no suggestion that Berlit could coextrude cotton. Reconsideration and withdrawal of the rejection is requested.

Claims 17,21,22,24,54 stand rejected under 35 U.S.C 103(a) as being unpatentable over Berlit et al. (as above) in view of Van der Goorbergh (EP 300578 A3). These claims depend from either claim 1 or claim 49 and are deemed patentable for the reasons already stated. Reconsideration and withdrawal of the rejection is requested.

Claims 20,23,27,28,36-40,55,56 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Berlit et al. (as above) in view of Flasch, Jr. (US 5,852,896). These claims depend from either claim 1, 29 or 49 and are deemed patentable for the reasons already stated. Reconsideration and withdrawal of the rejection is requested.

Furthermore, Applicant takes issues with the statement made in rejecting claim 23 regarding "the root-penetrable layer of R Berlit et al." (Office Action of Oct. 9, 2003 at pg. 7). As pointed out above, Berlit does not teach, show or suggest the use of a root-penetrable layer.

Claim 43 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Berlit et al. (as above) in view of Kalpin (US 3,094,810). Berlit discloses "a plant container 10 of which the bottom wall and circumferential wall are formed in one piece." (Berlit, pg. 1, lines 80-82 and Figure 1). Accordingly, there is no suggestion to combine Berlit with Kalpin for the purpose of sewing sheets together. Reconsideration and withdrawal of the rejection is requested.

Claim 45 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Berlit as modified by Reiger as applied to claim 33 above, and further in view of Billings (US 6,223,466 B1).

Claims 47,57,59,60-62 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Berlit et al. (as above) in view of Reiger (as above) and Flasch (as above).

Claim 58 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Berlit as modified by Reiger and Flasch as applied to claim 57 above, and further in view of Van der Goorbergh (as above).

Claims 45, 47, and 57-62 depend from claims already discuss as being patentable for a variety of reasons. These claims are patentable for at least the same reasons as the claims from which they depend. Reconsideration and withdrawal of these rejections is requested.

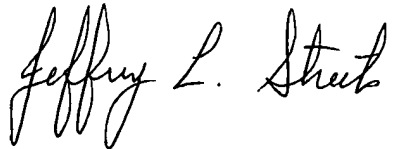
Applicant respectfully submits that all claims in the present application are entitled to allowance and such action is earnestly solicited. If the Examiner determines that a telephone conference would expedite the examination and allowance of this application, the undersigned requests that the Examiner call at her convenience.

Applicant also asserts that under MPEP 706.07(a) it would be improper for the next office action to be a final action, because any subsequent rejections would not be necessitated by Applicant's amendment (Applicant makes no amendments of the independent claims in this response) nor based on information submitted in an IDS since

the mailing of this office action (Applicant's earlier IDS submissions have already been considered). MPEP 707.02 then states that third and subsequent non-final office actions deserve special attention with a view to finally concluding its prosecution.

In the event that there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/WHIT/0002 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,

A handwritten signature in cursive script that reads "Jeffrey L. Streets".

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